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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,375

06/09/2005

Yoko Hanada

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04/30/2009

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ALEXANDRIA, VA 22314

EXAMINER

PALENIK, JEFFREY T

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

04/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/517,375	Applicant(s) HANADA ET AL.	
	Examiner Jeffrey T. Palenik	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-8,10,12,14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,9,11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10 Dec 2004 and 7 Dec 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RESPONSE TO REMARKS

The Examiner thanks the Applicants for their timely reply filed on 16 April 2008, in the matter of 10/517,375, as well as Applicants' timely filed response filed on 17 November 2008 to the Examiner's Request for Information.

Applicants' election **with traverse** of Group III (claims 1, 3, 9, 11 and 13) is acknowledged. Applicants traverse the lack of unity requirement on the grounds that Yamashina et al. (USPN 5,077,041) neither discloses nor suggests a block copolymer comprising a block of amino-modified organopolysiloxane chain and a block of a polyalkylene chain as recited in the elected Group III.

Applicants' request for reconsideration of the restriction requirement has been fully considered by the Examiner and **is persuasive**. However, upon further consideration of the claims submitted by Applicants, a new requirement follows. Regardless, the claims still do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same corresponding technical feature. There is no special technical feature since Claim 1 of Ando et al. (JP 1997-151119) teaches the block copolymer comprising a block of amino-modified organopolysiloxane chain and a block of a polyalkylene chain as recited in the elected Group III.

Also, Applicant's elections of the following species **with traverse** are acknowledged:

Organopolysiloxane Species: compound known as "FZ-3789", "Silstyle 201" or "bis-butyloxyamodimethicone/PEG-60 copolymer"

Cationic Surfactant Species: stearyltrimethylammonium chloride

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Lubricant Species: stearyl alcohol

The Examiner has reconsidered the aforementioned species elections and hereby **withdraws** the species requirement for the organopolysiloxane compound (A).

The remaining claims Group I (claim 6), Group II (claims 2, 7, 8, 10 and 12), and Group III (claims 4, 5, 14 and 15), are all withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions and/or species, there being no allowable generic or linking claim. Applicants timely traversed the lack of unity requirement between the compositions.

The remaining claims 1, 3, 9, 11 and 13 are presented and represent all claims under consideration.

INFORMATION DISCLOSURE STATEMENT

Two Information Disclosure Statements (IDS), filed 10 December 2004 and 7 December 2006, are acknowledged and have been reviewed.

CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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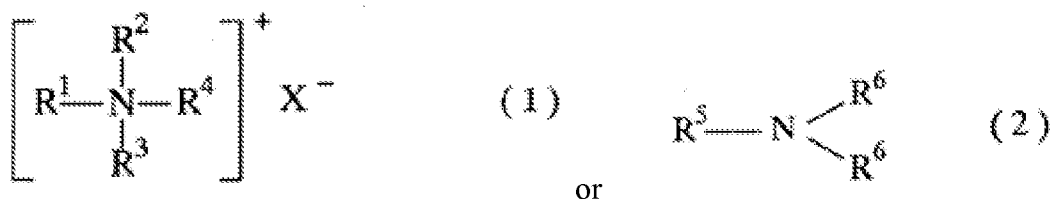
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

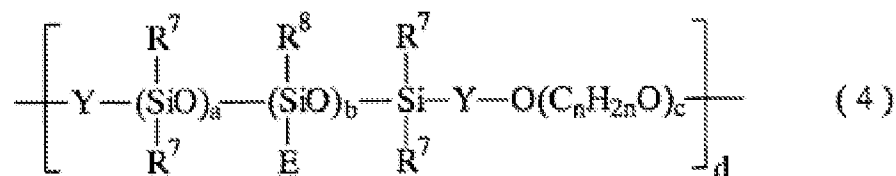
Claims 1, 3, 9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teachings of Kondo et al. (USPN 6,086,663) and Ando et al. (JP 1997-151119).

Independent claim 1 is directed to a hair cosmetic composition comprising components (A) and (B), wherein (A) is an amino-modified organopolysiloxane chain and a polyoxyalkylene chain, and (B) is at least one cationic surfactant having a core formula selected from the group consisting of formula (1) or (2):



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Claims 3 and 9 further limit the composition of claim 1 such that component (A) is in the form of a block copolymer of the following core formula (4):



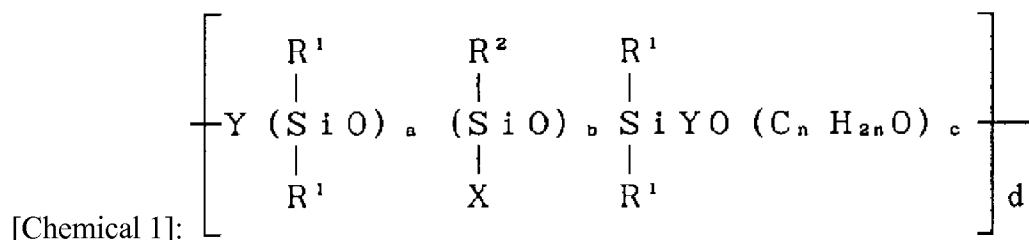
R₇ is recited as being a hydrogen or C₁-C₆ hydrocarbon group. R₈ is recited as being the same as R₇ or E, where E is a reactive functional group represented by -R₉Z-, where R₉ is a C₁-C₂₀ divalent hydrocarbon group and Z is a primary or tertiary amino group-containing group or an ammonium group-containing group, where “a” is 2 or greater, “b” is 1 or greater, “c” is 4 or greater, “d” is 2 or greater, “Y” is a divalent organic group bound via a carbon-silicon atom to the adjacent silicon atom via an oxygen atom to the polyoxyalkylene block chain. Claim 11 recites that the ratio of the siloxane block (A) is 25-97% by weight of the whole block copolymer. Claim 13, in accordance with the elected species, recites stearyl alcohol.

Kondo teaches surface modifier compositions for use in cosmetic compositions such as hair care products (Example 3). Comparative Example 6 is a composition comprising an amino-modified polysiloxane mixed with the cationic surfactant stearyltrimethylammonium chloride and cetyl alcohol. Stearyl alcohol is taught as a functionally equivalent aliphatic alcohol stabilizing compounds (col. 5, lines 29-33).

Kondo does not expressly teach the amino-modified polysiloxane as instantly claimed in claims 3, 9 and 11.

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Ando et al. expressly teach the limitations of claims 3 and 9, wherein a hair cosmetic ingredient is characterized by the inclusion of a reactive silicone-type block copolymer expressed by the following general formula:



Within the formula, R^1 signifies a monovalent hydrocarbon group (e.g. methyl), whereas “X” signifies a reactive functional group expressed by the following formula: $-\text{R}^3-\text{Z}$. The variable R^3 signifies a direct bond or divalent hydrocarbon group 1-20 carbon atoms in length, whereas “Z” represents a group comprising either an amino or ammonium group. The variable R^2 represents either R^1 or “X”. The variable “n” is an integer having a value of 2-4, “a” is an integer of at least 2, “b” is an integer of at least 1, “c” is an integer of at least 4, “d” is an integer of at least 2, and “Y” represents a divalent organic group coupled, via carbon-silicon, with an adjacent silicon atom and, via an oxygen atom, with a polyoxyalkylene block. The limitations of claim 11 are also taught by Ando in claim 1, such that the siloxane blocks constitute approximately 25-95 wt% of the whole block copolymer. Ando teaches in ¶[0017] that the practiced hair cosmetic ingredient discussed above, maybe further solubilized or dispersed (e.g. combined with) into an alcohol (e.g. cetyl alcohol; see Table IV) or dispersed within water by using a surfactant.

Ando et al. do not expressly teach either of the elected alcohol or cationic surfactant components of the instant invention.

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However, it would have been *prime facie* obvious to a person of ordinary skill at the time the invention was made to have incorporated the amino-modified organopolysiloxane component of Ando into the invention practiced by Kondo, particularly since both inventions are directed to the creation of cosmetic compositions, more specifically hair care products. Given that the intended uses of the amino-modified polysiloxanes compositions in both inventions is directed towards the preparation of hair-care products by mixture with alcohol and surfactants, it follows that the ordinarily skilled artisan would have been highly motivated to substitute the amino-modified organopolysiloxane-polyethylene oxide block copolymer (per Ando) for the amino-modified polysiloxane component taught by Kondo. Thus, since the inventions to Kondo and Ando demonstrate inventive overlap, as discussed above, one of ordinary skill in the art would also have been particularly motivated to prepare the instantly claimed hair cosmetic. Thus, it would have been *prima facie* obvious to combine the teachings, each of which are taught by the art as being useful for the same purpose, in order to form a third composition, such as that which is instantly claimed, to be used for the very same purpose; the idea of combining them flowing logically from their having been individually taught in the prior art (MPEP §2144.06). *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of evidence to the contrary.

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All claims have been rejected; no claims are allowed.

CORRESPONDENCE

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey T. Palenik whose telephone number is (571) 270-1966. The examiner can normally be reached on 7:30 am - 5:00 pm; M-F (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey T. Palenik/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615